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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/587,662      | 06/05/2000  | Jessie L.-S. Au      | JAG-004             | 8925             |

959 7590 09/09/2002

LAHIVE & COCKFIELD  
28 STATE STREET  
BOSTON, MA 02109

EXAMINER

KRISHNAN, GANAPATHY

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1623

DATE MAILED: 09/09/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/587,662

Applicant(s)

AU ET AL.

Examiner

Ganapathy Krishnan

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-89 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-89 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-28, 33-35 and 40-48, drawn to a method for inhibiting or reducing cell growth/cancer by administering telomere damage-inducing agent, classified in class 514, subclass 49, 50.
- II. Claims 29-31, and 89 drawn to methods of identifying cell growth inhibiting agent and method of detecting telomerase inhibitory agent, classified in class 435, subclass, 7.21.
- III. Claims 32 and 36 drawn to compositions containing the telomere damage-inducing agent, classified in class 424, subclass 9.2.
- IV. Claims 37-39 drawn to an article of manufacture, classified in class 435, subclass 975.
- V. Claims 49-56 drawn to methods of enhancing the efficacy of chemotherapeutic agent, classified in class 435, subclass 962.
- VI. Claims 57-88 drawn to methods of detecting telomerase activity and methods of determining telomere length, classified in class 435, subclass 4.

Inventions I through VI are all unrelated to each other. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the inventions are drawn to different methods, a composition and an article of manufacture each of which is not capable of being used together and each of which has different functions and effects.

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Inventions III and IV which are drawn compositions and an article of manufacture respectively, are not capable of use together or with any of the inventions I, II, V and VI which are drawn to methods of identification and detection. They also have different modes of operation.

Inventions I, II, V and VI which are drawn to method of inhibiting or reducing cell growth/cancer, method of identification of cell growth inhibiting agent, enhancing efficacy of chemotherapeutic agent and method of detecting telomerase activity and determining telomere length respectively, all have different modes of operation and different effects. The procedural steps used for inhibiting or reducing cell growth/cancer is different from those used to detect telomerase activity, telomere length and identification of telomere damage inducing agent.

Inventions I, II, V and VI are therefore unrelated to each other.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and divergent subject matter, restriction for examination purposes as indicated is proper.

It would indeed impose an undue burden upon the examiner in charge of this application if the instant restriction and species requirements are not advanced as set forth herein.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

In the event the applicants elect the inventions of Group I or of Group V, applicants are further required to respond to the following species requirement.

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Should applicants elect the inventions of Group I, the following species requirement contingent upon the specific identity of the telomere damage-inducing agent is required:

Species A, Telomere damage-inducing agent is paclitaxel classified in class 514, subclass 449

Species B, Telomere damage-inducing agent is nucleotide analog classified in class 514, subclass 49, 50

Should applicants elect the inventions of Group V, the following species requirement contingent upon the specific identity of the telomere damage-inducing agent is required:

Species A, Telomere damage-inducing agent is AZT classified in class 536, subclass 28.2

Species B, Telomere damage-inducing agent is nucleotide analog d4T classified in class 514, subclass 49, 50.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

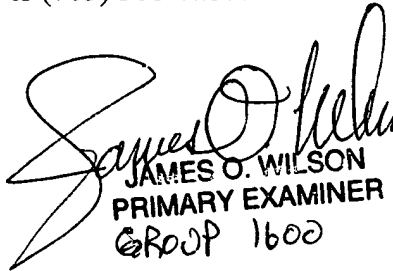
Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to James O. Wilson, Primary Examiner in Art Unit 1623 whose telephone number is (703) 308-4624. The examiner can normally be reached on Monday-Friday from 10:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter, can be reached on (703) 308-4532. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application's proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



JAMES O. WILSON  
PRIMARY EXAMINER  
GROUP 1600